

## REMARKS

In the office action mailed October 2, 2009, the Examiner rejected claims 18, 19 and 30, 32-39. By way of the foregoing amendments and the markings to show changes claims 18, 19, 37, and 39 have been amended, claims 22-24 and 27-28 have been cancelled, claims 21, 25-26, and 29 remain withdrawn, and claims 40-44 are new. No new matter has been added. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

### **A. Telephonic Interview**

Applicants would like to thank Examiner Phong H. Nguyen for the time and courtesy extended to Applicants' Representative Daniel Aleksynas during a telephonic interview conducted on January 28, 2010. Applicants agree with the substance of the interview regarding 35 U.S.C. § 112 second paragraph. In the interview, Applicants pointed out that no specific rejections were made regarding claims 30 and 35 and thank the examiner for clarification. Claims 18 and 37 were discussed, and the Applicants pointed out that the office action did not show where either reference disclosed a compressing step.

### **B. New Claims**

Applicants have added new claims 40-44. No new matter has been added. Support for the new claims under 35 U.S.C. § 112 can be found in U.S. Patent Application Publication

2007/0214923 at paragraphs 0019, 0023-0025, and 0034. The new claims add further limitations to the elected method claims 18 and 37 and are, therefore, proper.

**C. Drawings**

The office action objected to the drawings under 37 C.F.R. § 1.83(a) for failing to show every feature of the invention specified in the claims. Without acquiescence to this suggestion Applicants have amended claim 19 to remove the limitation fluting. Applicants believe this objection is moot and respectfully request that the objection be withdrawn.

**D. 35 U.S.C. § 112 first paragraph**

The office action rejected claim 19 under 35 U.S.C. § 112 first paragraph for allegedly not complying with the enablement requirement. Without acquiescence to this suggestion Applicants have removed fluting from claim 19. Applicants believe this rejection is moot and respectfully request this rejection be withdrawn.

**E. 35 U.S.C. § 112 second paragraph**

The office action rejected claim 30 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The office action stated that the phrase “such that the front shaped slice does not stick to the rear shaped slice” is confusing. The rejection was discussed in the interview and Applicants pointed to the specification of U.S. Patent Application 2007/0214923, paragraph six, which states: “in which the food product slices do not stick together.” The examiner indicated this support overcame the rejection.

**F. 35 U.S.C. § 103**

The office action rejected claims 18, 19, 30, 32-35, 37, and 38 as being unpatentable over Wiley et al. (3,855,889), in view of Walker (5,095,684).

**1) Lack of Fact Finding**

The office action does not set forth sufficient fact findings to support the rejection under 35 U.S.C. § 103 of claims 18, 30, 35, and 37. “All words in a claim must be considered in judging the

patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The office action has not shown where either Wiley or Walker teach every limitation of claims 18 and 37. Specifically, the office action has not put forth any evidence that either reference of record teaches, "**compressing the front shaped slice and the rear shaped slice so that the front shaped slice and the rear shaped slice are then slowed down and piled up**" and "**such that the shape of the front shaped slice and the rear shaped slice are changed relative to the shape of the food product slices before the slices are piled up.**" The office action does not list these limitations in the rejection. Therefore, a proper *prima facie* obviousness rejection has not been made. Without acquiescence to the suggestion in the office action that the compression step is taught; Applicants have amended claims 18 and 37 to clarify this step.

The office action has not shown where either Wiley or Walker teach any limitation of claim 35. Claim 35 states, "**A method as in claim 32, wherein the conveying speed of the second conveyor belt is less than the sum of the conveying speed of the first conveyor belt plus the speed at which a shaped product slice fall from the first conveyor belt onto the second conveyor belt.**" The office action failed to make any rejection of claim 35; thus, a proper *prima facie* rejection of claim 35 has not been made.

The office action has not shown where either Wiley or Walker teach every limitation in claims 30 and 37. Claims 30 and 37 state, "**such that the front shaped slice does not stick to the rear shaped slice.**" The office action does not list these limitations in the rejection; therefore, a proper *prima facie* obviousness rejection has not been made.

The office action further failed to show where either Wiley or Walker teaches, "**wherein the rear shaped slice is pushed up against the reshaped front slice such that the orientation of the front shaped slice and the rear shaped slice are changed,**" of claim 37. The office action has not show where this limitation is recited in the references of record, and Applicants respectfully request that the rejection be withdrawn.

The office action has failed to show where every limitation of claims 18, 30, 35, and 37 are taught by the references of record; therefore, a proper *prima facie* obviousness rejection has not been made. Applicants respectfully request that the rejections be withdrawn and claims 18, 30, 35, and 37, and their dependents be allowed.

## 2) Lack of Evidentiary Support for Fact Finding

Insufficient evidence has been presented to justify the combination of Wiley and Walker. In particular, no evidence has been presented that a skilled artisan would add the conveying system of Walker onto the slicing system of Wiley, or that a skilled artisan would substitute the substrate used in Wiley with the substrate used in Walker. Furthermore, no evidence has been presented that the conveying system of Walker can be used in conjunction with Wiley. Specifically, Walker teaches a hard substrate (i.e. a cookie), whereas Wiley teaches a flexible substrate (i.e. folded slices of food product). The office action has failed to present any evidence that these substrates are equivalents and, therefore, are substitutable.

Furthermore, as has previously been stated, Applicants believe that Wiley and Walker are not combinable. It is a goal of Walker to not damage the cookies while orienting the cookies. (see U.S. Patent 5,095,684 Column 3, lines 6-9). Applicants believe that Walker teaches away from this combination since it is a goal of Walker to NOT change the shape of its medium (i.e. Walker does not want to break cookies). The office action failed to explain how the Wiley/Walker combination will compress the slices. Applicants believe that the combination of Wiley and Walker is improper as illustrated above, and respectfully request the rejections in view of Wiley and Walker be withdrawn and the claims allowed.

Under *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007) in light of *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), Applicants believe that a proper 35 U.S.C. § 103 rejection was not made. Although the teaching-suggestion-motivation (TSM) test requirements as applied in *KSR* have been altered to be applied in a less rigid manner, the references still are not combinable, especially because Wiley in view of Walker does not address each of the claimed differences. The Court in *KSR* said:

Often, it will be necessary...to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**.

KSR, 82 USPQ2d at 1395 (emphasis added). The office action has failed to show any reason these two references are combinable, or that a person skilled in the art would combine these references. Therefore, a *prima facie* obviousness rejection has not been presented and Applicants respectfully request the rejections be withdrawn.

3) Inherency

The examiner in the interview summary alleges that the compression step is inherent in the Wiley/Walker combination. Applicants believe that the combination does not inherently teach compression as these references are not combinable, as has been illustrated above. Furthermore, in order for inherency to be proper:

the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 USPQ2d 1461 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Applicants do not believe that the examiner will be able to show that the compression step necessarily flows from the combination of Wiley and Walker because Walker expressly teaches—"minimiz[ing] damage to the cookies." Therefore, it is Applicants belief that the compression step does not necessarily flow from the teachings of the prior art.

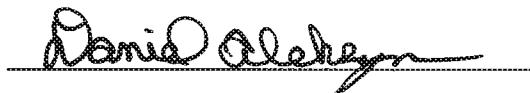
## CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

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